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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/731,754	10/18/96	OZAWA	M FUJ-13.208

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EMPIRE STATE BUILDING
NEW YORK NY 10118-6038

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EXAMINER	
LE.T	
ART UNIT	PAPER NUMBER
2514	

RECEIVED

DATE MAILED: 11/18/97

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HELFGOTT & KARAS

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

NOV 24 1997

DATE Feb 18 1998

May 18 1998

Office Action Summary

Application No.

08/731,754

Applicant(s)

Ozawa et al.

Examiner

Thien Le

Group Art Unit

2514



☒ Responsive to communication(s) filed on Oct 18, 1996

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-55 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 44, 50, and 55 is/are allowed.

☒ Claim(s) 1-8, 18-26, 36, 38-43, 45-49, and 51-54 is/are rejected.

☒ Claim(s) 9-17, 27-35, and 37 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the international Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The information disclosure statement and the preliminary remarks both filed on 10/18/96 have been entered. Claims 1-55 are presented for examination.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 of this title before the invention thereof by the applicant for patent.

3. Claims 1, 18-19, 36, 38-40, 45-46, 51, are rejected under 35 U.S.C. 102(e) as being anticipated by Steffen [5,574,270].

Regarding claim 1, Steffen discloses a card type interface 1 having transmission means 22 and 24 for connecting the card type interface with an external unit and a reader 4. Regarding the slot for accepting the card type interface, see 1.

Regarding claim 19, see the discussions regarding claim 1. Further, the card reader and external device must include the claimed third and fourth communication means for ensuring the proper operations of Steffen's system.

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Regarding claim 38, see the discussions regarding claim 1. Further Fig. 3C-D of Steffen for the circuit for transferring data between the transmission means.

Regarding claim 18, see Fig. 1 of Steffen for the interface between the card type interface and device 4.

Regarding claim 39, see the discussions regarding claims 1, 19 and 38.

Regarding claim 36, the contact interface on the card type interface is considered as the claimed electrical connector.

Regarding claim 40, see the discussions regarding claim 1, Fig. 1, 3C and 3D of Steffen. Specifically, Fig. 3C and 3D shows 8 bits parallel connection.

Regarding claims 45-46, see the discussions regarding claim 1, Fig. 1, 3C-3D.

Regarding claim 51, see the discussions regarding claims 1 and 40.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to

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the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 2-8, 20-26, 41-43, 47, 48-49, 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steffen [5,5704,270 - cited previously] in view of Yokoyama et al. [referred to as Yokoyama - 4,942,534].

Regarding claim 2, see the discussions regarding claim 1. The claim differs in calling for the use of a wireless communication means such as transmitter/receiver for a second transmission means. It would have been obvious to incorporate a transmitter/receiver as a second communication means. Reference to Yokoyama is cited as an evidence showing the use of a wireless communication means for an interface between a card and a card reader [see Fig. 3, 5, 7]. In view of this explicit teaching, an ordinary skilled artisan would have been motivated to modify the second transmission means to include a transmitter/receiver for wireless communication such as RF, ultrasonic, etc. The modification allows wireless transmission which thus allows remote communications which are critical in some working environments such as banking, credit transaction, non-contact systems, etc.

Regarding claim 3, see Fig. 1 of Steffen and the modification set forth in claim 2.

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Regarding claim 4, the use of a transmitter/receiver as discussed in claim 2 would inherently require an antenna.

Regarding claim 5, see the discussions regarding claims 2 and 4. The claim differs in calling for a rod-type antenna. It would have been obvious to incorporate a rod-type antenna in Steffen's card. The modification is merely incorporation of a known antenna which is apparent and plainly obvious to an ordinary skilled artisan. Without any unexpected result, the modification is merely a design consideration which is not considered novel.

Regarding 6, see the discussions regarding claim 2, 4 and 5. The claim differs in calling for an extractable/detractable rod antenna. It would have been obvious to incorporate such antenna in Steffen card. The modification allows the user to store the card type interface in a compact place. Further, vivid examples of the benefits of the use of an extractable/detractable rod antenna in various portable electronic devices such as portable telephones, radios, etc. motivate the artisan to make the modification.

Regarding claim 7, see the discussions regarding claim 6. The claim differs in calling for the means for allowing rotation of the rod type antenna. It would have been obvious to incorporate a gimble or other type of mounting in Steffen's card. The modification allows the user to adjust the position of the antenna in order to receive the optimum transmission.

Regarding claim 8, the claim differs in calling for the antenna on the edge of the card. This claim feature is considered inherent. This is because Steffen's transmission means are

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located at the end edges of the card type interface. Thus, the antenna as discussed in claims 2, 4-7 is considered to be located at the edge of the card type interface.

Regarding claim 21, see Fig. 1 of Steffen and the modification set forth in claim 2.

Regarding claim 20, see the discussions regarding claim 2. Further, the use of the claimed first and second wireless communication means must be included to ensure the proper operations of the system.

Regarding claim 22, see the discussions regarding claim 4.

Regarding claim 23, see the discussions regarding claim 5.

Regarding claim 24, see the discussions regarding claim 6.

Regarding claim 25, see the discussions regarding claim 7.

Regarding claim 26, see the discussions regarding claim 8.

Regarding claim 41, see the discussions regarding claims 2 and 40.

Regarding claim 42, see the discussions regarding claim 2.

Regarding claim 43, see the discussions regarding claim 40. The claim differs in calling for a parallel to serial converter. It would have been obvious to incorporate the use of a converter in Steffen's system. An ordinary skilled artisan would have been well aware of the use of a parallel to serial converter, and would have been motivated to incorporate a parallel to serial converter in Steffen's system to resolve differences between connecting systems.

Regarding claim 48, see the discussions regarding claim 2.

Regarding claim 49, see the discussions regarding claim 43.

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Regarding claim 52, see the discussions regarding claims 2 and 40.

Regarding claim 53, see the discussions regarding claim 2.

Regarding claim 54, see the discussions regarding claim 43.

Allowable Subject Matter

6. Claims 9-17, 27-35, 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 44, 50, 55 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose the card type interface as recited in claim 38 having thickness difference in the manner as recited in claims 9, 27, 44, 50 and 55. The prior art fails to disclose the claimed fifth data transmission means for communicating between the external device to another external device.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien Le whose telephone number is (703) 305-3500. The examiner can normally be reached on Monday to Friday from 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald T. Hajec, can be reached on (703) 308-4075. The fax phone number for this Group is (703) 308-7723.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**don.hajec@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

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A handwritten signature in cursive script, appearing to read 'Thien Le'.

Thien Le
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November 10, 1997